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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,732	10/30/2000	Michael J. Hearn	5143	6916

7590

05/20/2003

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EXAMINER

ROBINSON, BINTA M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/699,732

Applicant(s)

HEARN, MICHAEL J.

Examiner

Binta M. Robinson

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17 and 24-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: .

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Detailed Action

The 112, second paragraph rejection of claims 7-8, the 102 (b) rejections of claims 1, 17, 2, and 23 are withdrawn in light of applicant's amendment at paper no.

14/B. The restriction requirement made at paper no. 9 is made FINAL.

(New Rejections)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 and 24-27 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. Whether or not "R1, R2" as well as "R1R2" can independently be the substituents claimed or whether or not they come together to form a ring from the claimed substituents critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. The applicant has also not enabled all R2 equal to all substituted phenyl or naphthyl rings. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Whether or not the phrase "R, R2" in line 1 of claims 7 and 8 on pages 2 of the amendment 10/a and "R1R2" on line 8, in claim 21, line 3, page 4, claim 17, page 3 of the amendment 10/a refers to "R1" and "R2" independently representing the substituents claimed or coming together to form a ring from the substituents claimed is essential to the invention, because it is critical to know what the applicant's invention is via knowing what compounds the applicant is claiming. For example it is not clear in claim 7 if R1 and R2 can come together to form a pyridine ring that is then further substituted as indicated by "R1, R2" equaling "4-C6H8NNHCO-

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4-C₅H₄N". If in claim 7, R1 and R2 can come together to form pyridine ring, then this component of the claim would be nonelected.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim(s) 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claim 17, line 8, page 3, the phrase "R1R2" is indefinite and ambiguous. It is unclear as to whether or not "R1R2" independently representing the substituents claimed or coming together to form a ring from the substituents claimed.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim(s) 17, 24, 25, 26, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claim 17, line 5 and all other occurrences throughout the claims, 24, 25, 26, and 27, the phrases "substituted phenyls" and "substituted naphthyls" are indefinite. It is unclear as to what substituents on the phenyl or naphthyl ring the applicant is claiming. Is the applicant claiming any and every substituent?

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Response To Applicant's Remarks

During an interview with Rick Stevens on April 24, 2002, it was agreed to limit R2 to phenyl substituted with 1 to 3 substituents selected from the group consisting of a halogen, a hydroxyl, a methoxy, a benzyloxy, a phenoxy, a trifluoromethyl, an isopropyl, and a thiomethyl group. However, the applicant has since withdrawn this amendment made at paper no. 10/A. A 112, second paragraph rejection of the phrases "substituted phenyls" and "substituted naphthyls" is being made because it is not clear which substituents the applicant is claiming.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson



May 16, 2003



ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600